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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/774,030 | 02/05/2004 | David G. Hille | 200313598-1 | 7725 |
| 22879 | 7590 | 01/15/2008 | | |
| HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400 | | | EXAMINER TYLER, NATHAN K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2625 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 01/15/2008 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/774,030

Applicant(s)

HILLE ET AL.

Examiner

Nathan K. Tyler

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2 and 20 is/are allowed.
- 6) ☒ Claim(s) 3-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see page 8, filed 04 October 2007, with respect to claim 7 have been fully considered and are persuasive. The objection to claim 7 has been withdrawn.
2. Applicant's arguments with respect to claims 16 and 19 have been fully considered and are persuasive. The objection to claims 16 and 19 has been withdrawn.
3. Applicant states that the Sage Instruments 925VST Manual was not available on Sage Instruments' website as of December 17, 2002, and thus does not qualify as prior art under 35 U.S.C. Section 102(b). The examiner rechecked, and agrees that this manual was not available on Sage Instruments' website as of this date. However, an earlier version of the manual, which has no printed copyright date, was available on the website as of January 02, 2004 (<http://web.archive.org/web/20040102190106/http://www.sageinst.com/manuals.html>), and therefore qualifies as prior art under Section 102(e). Furthermore, the 925VST product was listed on Sage Instruments' website dating back more than a year before Applicant's filing date, and even though product documentation was not offered for download at that time, it is reasonable to assume that a similar user's manual was publicly available.
4. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.
5. Applicant's arguments with respect to claims 3, 7, 11 and 14 have been fully considered but they are not persuasive.

Regarding independent claims 3, 7, 11 and 14, Applicant argues that it would not have been obvious to add a phone line emulator to the device disclosed by Sage, as this device is meant to test only connections, not fax machines. In response, the Examiner respectfully disagrees. Version 1.0 of the Sage User's Manual, included with this office action, further details the possible outcomes of a fax test. As shown on pages 18 and 19, there are many errors that the 925VST unit is capable of detecting. Some of these errors are caused by a poor connection; however some of these errors can be caused by an incorrectly functioning fax machine. It is clear that while the primary goal of the 925VST unit is to test the physical connection, it is also quite capable of testing the proper functioning of a fax machine. Because several of these errors are ambiguous in nature, it would have been obvious at the time the invention was made to one of ordinary skill in the art to add a line emulator to the 925VST unit disclosed by Sage, in order to rule out the possibility that these ambiguous errors had been caused by a poor connection. Applicant also argues that the addition of a line emulator would render the 925VST test unit useless for its intended purpose. However, one of ordinary skill in the art would be capable of adding the line emulator in addition to the standard connections, rather than replacing them, thus allowing the tester to perform the original tests.

Regarding claim 7, Applicant argues that the tests performed by the Sage unit are not designed to test proper operation of the device under test. In response, the Examiner respectfully disagrees. While it is true that the primary goal of the fax test as disclosed by Sage is to ensure a properly functioning packet transmission over a communication line, if the responding device does not operate correctly, the test will fail. Additionally, pages 18 and 19 of the User Manual, v1.0, detail several detectable errors that are caused by an improperly functioning responder.

Therefore, even though this is not the primary goal of the fax test disclosed by Sage, this test is designed in such a way that proper functioning of the responder is tested.

6. Applicant's arguments with respect to claim 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sage Instruments (925VST VoP Service Tester User's Manual Version 1.0) and Johnson, Jr. et al. (US 6603569 B1), and further in view of Meyer (US 5396342 A).

Regarding **claim 3**, Sage discloses an expansion port (Sage, page 10 "Serial Port" heading: "Use the optional 925VST serial port (RS-232) cable...); a fax test module connected to the expansion port (the fax test module disclosed by Sage is connected to the serial (expansion) port), the fax test module including a telephone connector (figure on page 13, "RJ48") a fax modem module (page 6 shows "The fax emulator test operates with a standard facsimile machine." This fax emulator is a fax modem module); a display (cover page shows display); and, a processor that causes menus to be shown on the display, (Page 10, under "Interfaces"

heading: "To access the Interfaces screens, from the Main Menu press the 2 key to display the Setup menu..."), the menus allowing a user to select tests to be performed on a device under test (Page 32, "Running Tests" heading: "Use the [up] or [down] keys to scroll through the Test Select screens until the desired test displays..."), the tests including a send fax test (Page 18, "FAXTX" test, display shows "Transmit FAX").

Sage does not disclose a phone line emulator or a receive fax test.

Johnson discloses a facsimile transmission system with a phone line emulator (Fig. 4, numeral 412 "Line Emulator." "The line emulator provides line current, dial-tone, ring signals, and busy signals typically furnished by a telephone network central office." At column 5, line 45).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the fax test system disclosed by Sage with the phone line emulator disclosed by Johnson so that the device under test could be tested without connecting through a telephone line provided by a central office ("The line emulator provides line current, dial-tone, ring signals, and busy signals typically furnished by a telephone network central office." At column 5, line 45).

The combination of Sage and Johnson does not disclose a receive fax test.

Meyer discloses a facsimile testing system that is capable of both a send fax test and a receive fax test ("By providing a system that sends and receive fax messages like an ordinary fax transceiver but also can make and process measurements while it is doing so..." at column 3, line 16).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the fax test system disclosed by the combination of Sage and Johnson with a

receive fax test as taught by Meyer, so that the fax test system could test the ability of the device under test to transmit as well as receive faxes.

Regarding **claim 4**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that the menus include a select product menu and a select test menu (Sage, page 14, "Running Tests" heading: "Use the [up] or [down] keys to scroll through the Test Select screens until the desired test displays..." Sage page 10, "Test Interface" heading: "Use the Interfaces screens to select the type of line to be tested").

Regarding **claim 5**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that the menus include a select category menu (Sage, page 14, "Interfaces" display screen used to select which category of line, <test interface> lines (products) or Serial Port), a select product menu (see grounds for rejection for claim 4) and a select test menu (see grounds for rejection for claim 4).

Regarding **claim 6**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that the menus list devices that can be tested by the diagnostic tool (see grounds for rejection for claim 3); and the menus list at least one device that does not have fax capability and at least one device that does have fax capability (see grounds for rejection for claim 3).

Regarding **claim 7**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses power circuitry based on power supplied by battery (Sage, page 9, "Initial Charge" heading: "The 925VST comes with rechargeable batteries installed at the factory."); an expansion port (see grounds for rejection for claim 3); a fax test module (see grounds for

rejection for claim 3), the fax test module including a telephone connector, a fax modem module, and a phone line emulator; a display; and, a processor that causes menus to be shown on the display, the menus allowing a user to select tests to be performed on a device under test, the tests being designed to determine proper operation of the device under test (see response to arguments) the tests including a send fax test, and a receive fax test (see grounds for rejection for claim 3).

Regarding **claim 8**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that the menus include a select product menu and a select test menu (see grounds for rejection for claim 4).

Regarding **claim 9**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that the menus include a select category menu, a select product menu and a select test menu (see grounds for rejection for claim 5).

Regarding **claim 10**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that the menus list devices that can be tested by the diagnostic tool (see grounds for rejection for claim 3); and the menus list at least one device that does not have fax capability and at least one device that does have fax capability (see grounds for rejection for claim 3).

Regarding **claim 11**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses a method for testing a device under test (DUT) comprising connecting a cable from the DUT to a diagnostic tool (Sage, page 31, "RJ Connections" heading: "Use the supplied cords to connect the 925VST to the line being tested); and, sending a fax from the diagnostic tool to the DUT (Sage, page 36, "FAXTX" display shows fax has been successfully transmitted from the diagnostic tool to the DUT), including the following: emulating, by the diagnostic device over

the cable, a phone line to the DUT (“The line emulator provides line current, dial-tone, ring signals, and busy signals typically furnished by a telephone network central office.” At Johnson column 5, line 45), performing fax transmission of data from the diagnostic tool to the DUT (Sage, page 36, “FAXTX” display shows fax has been successfully transmitted from the diagnostic tool to the DUT), and terminating the fax transmission (“Transmit FAX Passed” shown on the display signifies that the test has been completed correctly, therefore the transmission has ended).

Regarding **claim 12**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that emulating the phone line includes producing an alert signal (“The line emulator provides line current, dial-tone, ring signals, and busy signals...” At Johnson column 5, line 45).

Regarding **claim 13**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses the following performed before sending the fax: selecting by a user the device under test from a plurality of devices listed on a menu by the diagnostic tool (Sage, page 32, “Running Tests” heading: “Use the [up] or [down] keys to locate the desired responder (far end) phone number), the plurality of devices including at least one device that does not have fax capability and at least one device that does have fax capability (see grounds for rejection for claim 3).

Regarding **claim 14**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses a method for testing a device under test (DUT) comprising connecting a cable from the DUT to a diagnostic tool (see grounds for rejection for claim 11); and, sending a fax from the DUT to the diagnostic tool (“In one mode of operation, the user initiates a test by automatically transmitting a sample document, such as a cover page or test chart to a special fax telephone number where the test system is located” at Meyer column 3, line 28), including the following:

emulating, by the diagnostic device over the cable, a phone line to the DUT (see grounds for rejection for claim 11), performing fax transmission of data from the DUT to the diagnostic tool (“In one mode of operation, the user initiates a test by automatically transmitting a sample document, such as a cover page or test chart to a special fax telephone number where the test system is located” at Meyer column 3, line 28), and terminating the fax transmission (“The system analyzes the measurements and prepares a test report, which is then immediately delivered to the caller by fax message” at Meyer column 3, line 35. In order for the system to send the report back to the DUT, the original fax transmission must have been terminated).

Regarding **claim 15**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that emulating the phone line includes producing a dial tone (“The line emulator provides line current, dial-tone...” At Johnson column 5, line 45); and receiving a dialed number (“The line emulator 412 also decodes DTMF tones and traps the corresponding digits dialed by local fax machine 102” at Johnson column 5, line 47).

Regarding **claim 16**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses the following performed before sending the fax from the DUT to the diagnostic tool: selecting by a user the device under test from a plurality of devices listed on a menu by the diagnostic tool, the plurality of devices including at least one device that does not have fax capability and at least one device that does have fax capability (see grounds for rejection for claim 13).

Regarding **claim 17**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses sending a fax from the diagnostic tool to the DUT, including the following emulating again, by the diagnostic device, a phone line to the DUT, performing fax transmission of data

from the diagnostic tool to the DUT, and terminating the fax transmission (see grounds for rejection for claim 11).

Regarding **claim 18**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses that emulating again the phone line includes producing an alert signal (see grounds for rejection for claim 12).

Regarding **claim 19**, the combination of Sage, Johnson, and Meyer as applied to claim 3 discloses the following performed before sending the fax from the diagnostic tool to the DUT: selecting by a user the device under test from a plurality of devices listed on a menu by the diagnostic tool, the plurality of devices including at least one device that does not have fax capability and at least one device that does have fax capability (see grounds for rejection for claim 13).

Allowable Subject Matter

9. Claim 1, 2, and 20 are allowed.

10. The following is an examiner's statement of reasons for allowance:

Independent claims 1 and 20 are directed to a diagnostic tool for testing proper operation of facsimile devices, the tool displaying a menu that allows the user to select a test to perform. Claims 1 and 20 identify the uniquely distinct features of "the menus list types of devices for which the diagnostic tool includes tests that are meant to determine whether a tested device from the types of devices is operating properly."

The closest prior art Sage (925VST User's Manual, v1.0) teaches that the menus list devices to test by phone number, not by type of device, and therefore either singularly or in combination with other cited references fails to anticipate or render the above underlined limitations obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

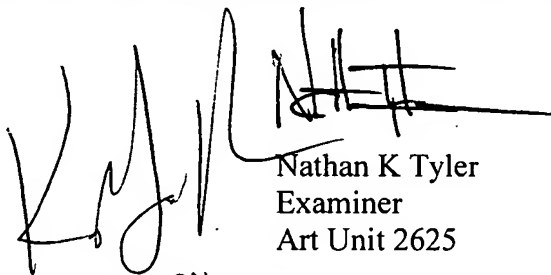
Application/Control Number:
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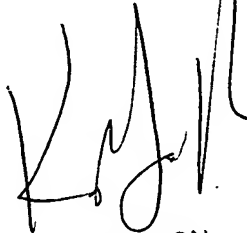
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan K. Tyler whose telephone number is 571-270-1584. The examiner can normally be reached on M-F 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan K Tyler
Examiner
Art Unit 2625



KING Y. POON
SUPERVISORY PATENT EXAMINER